

Theodore K. Stream, State Bar #138160  
1 Email: [Ted.Stream@streamkim.com](mailto:Ted.Stream@streamkim.com)  
2 Mario H. Alfaro, State Bar #246420  
Email: [Alfaro@streamkim.com](mailto:Alfaro@streamkim.com)  
3 **STREAM KIM HICKS WRAGE & ALFARO, PC**  
4 3403 Tenth Street, Suite 700  
Riverside, CA 92501  
Telephone: (951) 783-9470  
5 Facsimile: (951) 783-9475

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7 Attorneys for Defendant, MINKA LIGHTING, INC.

8 **UNITED STATES DISTRICT COURT**  
9 **CENTRAL DISTRICT OF CALIFORNIA**  
10 **EASTERN DIVISION**

11 VAXCEL INTERNATIONAL CO., LTD., } CASE NO.: 5:18-cv-02549-GW (SHKx)  
12 Plaintiff, }  
13 vs. }  
14 MINKA LIGHTING, INC. }  
15 Defendant. }  
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**DEFENDANT MINKA LIGHTING INC.'S ANSWER AND COUNTERCLAIM TO PLAINTIFF VAXCEL INTERNATIONAL CO. LTD.'S COMPLAINT**

**DEMAND FOR JURY TRIAL**

19 Defendant Minka Lighting, Inc. ("Minka" or "Defendant") hereby answers  
20 the Complaint filed by Plaintiff Vaxcel International Co. Ltd. ("Vaxcel" or  
21 "Plaintiff"). Each numbered paragraph of the Answer corresponds to the same  
22 numbered paragraph of the Complaint.

23 **PARTIES**

- 24 1. Minka admits the allegations contained in Paragraph 1 of the  
Complaint.  
25  
26 2. Minka admits the allegations contained in Paragraph 2 of the  
Complaint.

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27  
28 **DEFENDANT MINKA LIGHTING INC.'S ANSWER AND**  
**COUNTERCLAIM TO PLAINTIFF VAXCEL**  
**INTERNATIONAL CO. LTD.'S COMPLAINT**

3. Minka admits the allegations contained in Paragraph 3 of the Complaint.

## **JURISDICTION AND VENUE**

4. Minka admits the allegations contained in Paragraph 4 of the Complaint.

5. Minka admits the allegations contained in Paragraph 5 of the Complaint.

6. Minka admits that it regularly conducts business in the Central District of California. Minka denies that it has committed any acts or omissions giving rise to Plaintiff's claims in this or any other judicial district and the remaining allegations contained in Paragraph 6 of the Complaint.

7. Minka denies the allegations contained in Paragraph 7 of the Complaint.

8. Minka admits that this Court has personal jurisdiction over it. Minka denies the remaining allegations contained in Paragraph 8 of the Complaint.

9. Minka admits that venue is proper in the Central District of California. Minka denies the remaining allegations in Paragraph 9 of the Complaint.

## BACKGROUND

10. Minka is without sufficient information to form a belief as to the truthfulness of the allegations contained in Paragraph 10 of the Complaint, and therefore denies them.

11. Minka is without sufficient information to form a belief as to the truthfulness of the allegations contained in Paragraph 11 of the Complaint, and therefore denies them.

12. Minka admits that United States Patent No. 10,117,313 (“the ’313 Patent”) issued on October 30, 2018. Minka denies the remainder of the allegations contained in Paragraph 12 of the Complaint.

13. Minka is without sufficient information to form a belief as to the truthfulness of the allegations contained in Paragraph 13 of the Complaint, and therefore denies them.

14. Minka admits that it is not a licensee of Vaxcel and denies that it needs a license from Vaxcel. Minka denies the remainder of the allegations contained in Paragraph 14 of the Complaint.

## COUNT I

# PATENT INFRINGEMENT OF U.S. PATENT NO. 10,117,313

15. Minka repeats and realleges its answers to Paragraphs 1 through 14 of the Complaint as if fully set forth herein.

16. Minka admits that it manufactures, distributes, and markets its lighting products. Minka denies the remainder of the allegations contained in Paragraph 16 of the Complaint.

17. Minka admits that it sells lanterns or lamps with a motion detector exclusively to Home Depot and denies the remainder of the allegations contained in Paragraph 17 of the Complaint.

18. Minka denies the allegations contained in Paragraph 18 of the Complaint.

19. Minka denies the allegations contained in Paragraph 19 of the Complaint.

20. Minka denies the allegations contained in Paragraph 20 of the Complaint.

21. Minka admits that it imports, sells, and/or offers to sell the Port Oxford (Model No. 22211) and the McCarthy (Model No. 22411) lamps with a motion detector exclusively to Home Depot. Minka denies the remainder of the allegations contained in Paragraph 21 of the Complaint.

22. Minka denies the allegations contained in Paragraph 22 of the

## Complaint.

23. Minka denies the allegations contained in Paragraph 23 of the Complaint.

24. Minka denies the allegations contained in Paragraph 24 of the Complaint.

25. Minka admits that the documents attached as Exhibit C and Exhibit D to Plaintiff's Complaint contain the quoted language. Minka denies the remainder of the allegations contained in Paragraph 25 of the Complaint.

26. Minka denies the allegations contained in Paragraph 26 of the Complaint.

27. Minka denies the allegations contained in Paragraph 27 of the Complaint.

28. Minka denies the allegations contained in Paragraph 28 of the Complaint.

29. Minka denies the allegations contained in Paragraph 29 of the Complaint.

30. Minka denies the allegations contained in Paragraph 30 of the Complaint.

31. Minka denies the allegations contained in Paragraph 31 of the Complaint.

## AFFIRMATIVE DEFENSES

1. Subject to and without waiver of the denials and responses contained in its Answer, Minka alleges as follows as its affirmative defenses. In asserting these defenses, Minka does not assume the burden of proof as to matters that, pursuant to

1 law, are Vaxcel's burden to prove.

2 **FIRST AFFIRMATIVE DEFENSE**

3 2. Minka has not infringed, willfully infringed, contributed to  
4 infringement of, or actively induced others to infringe, and does not willfully or  
5 otherwise infringe, contribute to infringement of, or actively induce others to  
6 infringe any valid claim of the '313 Patent.

7 **SECOND AFFIRMATIVE DEFENSE**

8 3. The claims of the '313 Patent are invalid for failure to satisfy or comply  
9 with 35 U.S.C. §§ 101, 102, 103, 112, and/or any other judicially created doctrines  
10 such as the doctrine of obviousness-type double patenting.

11 **THIRD AFFIRMATIVE DEFENSE**

12 4. By reason of the prosecution of the application for the '313 Patent,  
13 Plaintiff is estopped from construing the claimed inventions of the '313 Patent (or  
14 any equivalent thereof) as applying to any product made, used, sold, and/or offered  
15 for sale by Minka.

16 **FOURTH AFFIRMATIVE DEFENSE**

17 5. Plaintiff's claims in this action are barred under the equitable doctrines  
18 of estoppel, laches, acquiescence, and/or unclean hands.

19 **FIFTH AFFIRMATIVE DEFENSE**

20 6. Plaintiff is not entitled to any damages or profits in this action for any  
21 alleged infringement prior to filing this Complaint because Plaintiff failed to comply  
22 with the marking requirements of 35 U.S.C. § 287(a).

23 **SIXTH AFFIRMATIVE DEFENSE**

24 7. Plaintiffs fail to state a proper claim for an exceptional case and/or  
25 willful infringement. No acts by Minka give rise to an exceptional case under 35  
26 U.S.C. § 285.

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STREAM|KIM  
ATTORNEYS AT LAW  
3403 TENTH STREET,  
STE 700  
RIVERSIDE, CA 92501  
951-783-9470

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28 **DEFENDANT MINKA LIGHTING INC.'S ANSWER AND  
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## **SEVENTH AFFIRMATIVE DEFENSE**

8. Minka reserves the right to assert any and all additional defenses and counterclaims that may be developed, whether through discovery, further investigation, and/or otherwise, including defenses or counterclaims of unenforceability.

## COUNTERCLAIMS

Defendant and Counterclaim-Plaintiff Minka Lighting Inc. (“Minka”) for these counterclaims against Plaintiff and Counterclaim-Defendant Vaxcel International Co., Ltd. (“Vaxcel”), alleges as follows.

## THE PARTIES

1. Minka is incorporated under the laws of the State of California, with its principal place of business at 1151 West Bradford Court, Corona, California 92882.

2. Vaxcel is, on information and belief, an Illinois corporation with its principal place of business located at 121 E. North Avenue, Carol Stream, Illinois 60188.

## **JURISDICTION AND VENUE**

3. These Counterclaims are an action for declaratory judgment of patent non-infringement and/or patent invalidity pursuant to 28 U.S.C. §§ 2201 and 2202.

4. These Counterclaims arise under the laws of the United States, and this Court has subject matter jurisdiction over these counterclaims pursuant to 28 U.S.C. §§ 1331 and 1338(a), as well as under the Declaratory Judgment Act, 28 U.S.C. §§ 2201 and 2202. The Court also has subject matter jurisdiction over this controversy under 28 U.S.C. § 1332 as the action is between citizens of different states and the amount in controversy in this action, exclusive of interest and costs, exceeds the sum of \$75,000.

5. This Court has personal jurisdiction over Vaxcel because Vaxcel filed the Complaint in this Court, alleging infringement of the '313 Patent by Minka, and

1 because, on information and belief, Vaxcel conducts substantial business in this  
2 District and has engaged in systematic and regular contact with this District.

3       6.     Venue is proper in this District pursuant to 28 U.S.C. §§ 1391(b) and  
4 (c) because this Court has personal jurisdiction over Vaxcel and because a  
5 substantial part of the events giving rise to Minka's declaratory judgment claims  
6 occurred in this District. Minka is also Defendant and Counter-Plaintiff, and resides  
7 in the Eastern Division of the Central District of California. Minka alleges that this  
8 case should be dismissed or consolidated with Case Nos. 5:18-cv-01484 GW  
9 (SHKx), styled *Vaxcel International Co., Ltd. v. Minka Lighting, Inc.*

## BACKGROUND

11       7. Vaxcel alleges in the Complaint that United States Patent No.  
12 10,117,313 (the “313 Patent”) issued on October 30, 2018.

13 8. Vaxcel alleges in its Complaint that it is the assignee of the '313 Patent.

14        9. Vaxcel purports to be the owner of all right, title, and interest in the  
15 '313 Patent.

16        10. On December 4, 2018, Vaxcel filed its Complaint in this Court alleging  
17 Minka has infringed the '313 Patent by commercial manufacture, use, offer to sell,  
18 sale, or importation of certain Minka products.

19        11. There is an actual, substantial and justiciable controversy between  
20 Minka and Vaxcel relating to the non-infringement and/or invalidity of the '313  
21 Patent.

## COUNT I

## **NON-INFRINGEMENT OF THE '313 PATENT**

24        12. Minka repeats and realleges and incorporates by reference all preceding  
25 paragraphs of the Counterclaims as if fully set forth herein.

26        13. Minka has not, does not, and will not infringe any valid or enforceable  
27 claim of the '313 Patent by the manufacture, use, offer to sell, sale, or importation

of any Minka products, including but not limited, to the Port Oxford (Model No. 22211) and the McCarthy (Model No. 22411) lamps with a motion detector (the “Accused Products”).

4        14. The Accused Products have not infringed and do not infringe any claim  
5 of the '313 Patent, either directly or indirectly, literally or under the Doctrine of  
6 Equivalents. More particularly, the Accused Products lack at least the exemplary  
7 limitations of independent claims 1, 9, and 11 that call for "a cover[,] partially  
8 covering the sensing unit; wherein . . . the at least one sensor at the first side of the  
9 sensing unit is not blocked and is capable of performing sensing function when the  
10 sensing unit is rotated to the first angle, [wherein] the at least one parameter adjusting  
11 element at the second side of the sensing unit is exposed to being adjusted when the  
12 sensing unit is rotated to the second angle." Pursuant to the requirements of the  
13 exemplary limitations in independent claims 1, 9, and 11, neither the alleged  
14 "sensor" nor the alleged "parameter adjusting element" is covered by the cover in  
15 either the alleged "first angle" or the alleged "second angle" positions for the  
16 Accused Products.

17        15. Minka is entitled to a judicial declaration that it has not infringed, and  
18 that the commercial manufacture, use, offer to sell, sale, or importation of any Minka  
19 products will not infringe, any valid or enforceable claim of the '313 Patent.

20        16. This is an exceptional case under 35 U.S.C. § 285 and Minka is entitled  
21 to an award of its costs, expenses and reasonable attorneys' fees.

## COUNT II

## **INVALIDITY OF THE '313 PATENT**

24        17. Minka repeats and realleges and incorporates by reference all preceding  
25 paragraphs of the Counterclaims as if fully set forth herein.

26 18. One or more claims of the '313 Patent are invalid under 35 U.S.C. §§  
27 101, 102, 103, 112 and/or any judicially created doctrines such as the doctrine of

<sup>1</sup> || obviousness-type double patenting.

2        19. One or more claims of the '313 Patent are invalid as obvious to a person  
3 of ordinary skill in the art under 35 U.S.C. § 103 at least over U.S. Patent No.  
4 7,473,899 or U.S. Patent 5,590,953 in view of other prior art.

5        20. This is an exceptional case under 35 U.S.C. § 285 and Minka is entitled  
6 to an award of its costs, expenses and reasonable attorneys' fees.

## **PRAYER FOR RELIEF**

8 WHEREFORE, Counter-Plaintiff Minka prays for a judgment against  
9 Counter-Defendant Vaxcel as follows:

1. Dismissing the Complaint in its entirety with prejudice;
  2. Entering judgment in favor of Minka;
  3. A declaration that the manufacture, use, offer to sell, sale, or  
importation of any accused Minka product has not, does not, and will not infringe  
any valid or enforceable claim of the '313 Patent;
  4. A declaration that the manufacture, use, offer to sell, sale, or  
importation of any accused Minka product has not, does not, and will not not  
contributorily infringe any valid or enforceable claim of the '313 Patent;
  5. A declaration that the manufacture, use, offer to sell, sale, or  
importation of any accused Minka product has not, does not, and will not induce  
infringement of any valid or enforceable claim of the '313 Patent;
  6. A declaration that one or more claims of the '313 Patent are invalid;
  7. A declaration that this case is exceptional under 35 U.S.C. § 285.
  8. Awarding Minka its reasonable costs and attorneys' fees incurred in  
defending this action pursuant to 35 U.S.C. § 285; and

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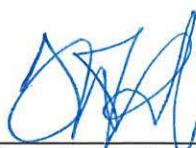
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**STREAM|KIM**  
ATTORNEYS AT LAW  
3403 TENTH STREET,  
STE 700  
RIVERSIDE, CA 92501  
951-783-9470

1           9. Awarding Minka such other and further relief as the Court deems just  
2 and proper.

3           Dated: February 1, 2019

4           STREAM KIM HICKS WRAGE & ALFARO, PC

5           By: 

6           Theodore K. Stream  
7           Mario H. Alfaro  
8           Attorneys for Defendant  
9           MINKA LIGHTING, INC.

10           **DEMAND FOR JURY TRIAL**

11           Defendant and Counter-Plaintiff Minka hereby demands a jury trial, as  
12 provided by Rule 38(a) of the Federal Rules of Civil Procedure.

14           Dated: February 1, 2019

15           STREAM KIM HICKS WRAGE & ALFARO, PC

16           By: 

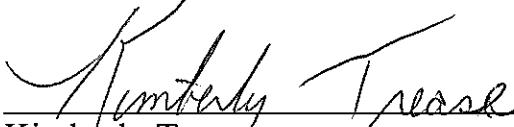
17           Theodore K. Stream  
18           Mario H. Alfaro  
19           Attorneys for Defendant  
20           MINKA LIGHTING, INC.

Vaxcel International Co., Ltd vs. Minka Lighting, Inc.  
USDC-Central District – Case No.: 5:18-cv-02549-GW-SHKx

**CERTIFICATE OF SERVICE**

I hereby certify that on February 1, 2019, I electronically filed the foregoing  
**DEFENDANT MINKA LIGHTING INC.'S ANSWER AND  
COUNTERCLAIM TO PLAINTIFF VAXCEL INTERNATIONAL CO.  
LTD.'S COMPLAINT – DEMAND FOR JURY TRIAL** with the Clerk of the  
Court using the CM/ECF system which will send notification of such filing to the  
ECF registrants at the email addresses indicated on the attached Service List.

I certify under penalty of perjury under the laws of the United States of  
America that the foregoing is true and correct. Executed on February 1, 2019,  
Riverside, California.

  
\_\_\_\_\_  
Kimberly Trease  
Stream Kim Hicks Wrage & Alfaro, PC  
3403 Tenth Street, Ste. 700  
Riverside, CA 92501  
Telephone: (951) 783-9470  
Facsimile: (951) 783-9475  
Email: [kimberly.trease@streamkim.com](mailto:kimberly.trease@streamkim.com)

Vaxcel International Co., Ltd vs. Minka Lighting, Inc.  
USDC-Central District – Case No.: 5:18-cv-02549-GW-SHKx

## **SERVICE LIST**

## **Electronic Mail Notice List:**

Adriana Cara, Esq.  
FISHER BROYLES, LLP  
1902 Wright Place, Suite 200  
Carlsbad, CA 92008  
Telephone: (760) 918-5635  
Facsimile: (760) 918-5638  
Email: [adriana.cara@fisherbroyles.com](mailto:adriana.cara@fisherbroyles.com)

Atorneys for Plaintiff,  
**VAXCEL INTERNATIONAL  
CO., LTD.**

Robert M. Halligan, Esq.  
FISHER BROYLES, LLP  
203 North La Salle Street, Suite 2100  
Chicago, IL 60601  
Telephone: (312) 607-0102  
Email: [rmarkhalligan@fischerbroyles.com](mailto:rmarkhalligan@fischerbroyles.com)

Attorneys for Plaintiff,  
**VAXCEL INTERNATIONAL  
CO., LTD.**